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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,527	09/12/2003	Tetsuro Motoyama	241499US2CONT	5289

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EXAMINER	
PRIETO, BEATRIZ	

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,527	MOTOYAMA ET AL.	
	Examiner	Art Unit	
	Prieto B	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/03, 12/03, 5/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Application No. 10/660,527 filed 09/12/03, claims 1-12 remain pending.

2. Acknowledge is made to domestic priority information provided in the application data sheet for benefit claimed under 35 U.S.C. 119(E), 120, 121 or 365(c) and need not otherwise be made part of the specification (see MPEP 601.05).

3. Information Disclosure statements (IDS) submitted on 09/12/03, 12/12/03 & 05/04/04 was filed prior to the mailing date of the first office action. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner and initialed accordingly.

Claim Rejection under 35 U.S.C 101

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent '247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application is an obvious variation of the '247 patent.

Claim 1 of the application has substantially the same substance of claims 1 and 6 of the 247 patent. Both the application and '247 patent in substance transfer status information from a network device to a first computer and thereafter to a second computer. The difference between the application and the patent is that in the application a determination as to whether to transfer to the second computer is made, in instant application a report is periodically generated for transmission to a computer. The noted difference between the conflicting claims is not suffice to render the invention of claim 1 of the application patentably distinct and/or therefore substantially the same invention and/or a mere obvious variation of the patent '247.

Barrett teaches the transmission of log file information based on a predetermined condition including inter alia when a predetermined time has been met, thereby periodically transmitting information to a computer (col 2/lines 11-26), the information including status information (col 25/lines 47-55), the processing and formatting in response to said predetermined condition obtained status information to generate report (Fig. 29, col 35, lines 16-50). It would have been obvious to one ordinary skilled in the art at the time the invention to periodically process and format status information for transmission to a computer by the device itself or by a computer as discussed by Barrett enabling the periodic transmission of status information base on predetermined condition such as when sufficient information is available or a memory capacity has been met, upon demand or in response to a predetermined time being met, set forth by Barrett.

6. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,544,289 (referred to as patent '289 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application is an obvious variation of the '289 patent.

7. Claims 1 and 3 of the application has substantially the same substance of claim 1 of the '289 patent. Both the application and '289 patent in substance transfer information in a copier to a computer, where the information changes with time. The difference between the application and the patent is that in the application a determination as to whether to transfer to the second computer is made, in instant application a report is periodically generated for transmission to a computer. The noted difference between the conflicting claims is not suffice to render the invention of claims 1/3 of the application patentably distinct and/or therefore substantially the same invention and/or a mere obvious variation of the patent '289.

Barrett teaches the transmission of log file information based on a predetermined condition including inter alia when a predetermined time has been met, thereby periodically transmitting information to a computer (col 2/lines 11-26), the information including status information (col 25/lines 47-55), the processing and formatting in response to said predetermined condition obtained status information to generate report (Fig. 29, col 35, lines 16-50). It would have been obvious to one ordinary skilled in the art at the time the invention to periodically process and format status information for transmission to a computer by the device itself or by a computer as discussed by Barrett enabling the periodic transmission of status information base on predetermined condition such as when sufficient information is available or a memory capacity has been met, upon demand or in response to a predetermined time being met, set forth by Barrett.

Claim Rejection under 35 U.S.C. 101

8. Claims 1 is rejected under 35 U.S.C. § 101 which reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In this case, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material *per se* (see *Warmerdam, 33 F.3d at 1360 USPQ2d at 1759)*, falling under the "process" category (i.e. inventions at that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process means, art, or method, and includes a new of a known process, machine, manufacture, composition of matter or material"). Functional descriptive material: "data structures" representing descriptive material *per se* or

computer program representing computer listing *per se* when embodied in a computer-readable media are still not statutory because they are not capable of causing functional change in the computer. However, claimed computer-readable medium encoded with a data structure defined structural and functional interrelationships between the data structure and the computer software and hardware component, which permit the data structure's functionality to be realized, and is thus statutory (see MPEP 2106).

Claim Rejection under 35 U.S.C 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claim 1, 5 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by HASHIMOTO et. al. U.S. Patent No. 5,897,236 (Hashimoto hereby).

Regarding claims 1, 5 and 9, Hashimoto discloses features of the invention as claimed, including as shown in Fig. 4, a network device (1) communicatively coupled to a network, comprising:

accessing the network device (1) by a first computer (18) to obtain device status information of the network device (col 8/lines 66-col 9/line 4), including information obtained from sensors of the network device (col 8/lines 36-40), information including usage information (col 9/lines 5-10, col 10/lines 51-54 and Figs. 14A and 14B;

storing the obtained device status information at the first computer (col 1/lines 1-4);

periodically processing the stored status information to generate a collection of said information (called "usage report") for the network device (col 9/lines 6-30, col 10/lines 2-4, 17-19, 29-31);

transmitting the usage report from the first computer to a second computer (col 9/lines 48-67); and

receiving the usage report by the second computer from the first computer (col 15/lines 60-63).

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 5-7 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by HASHIMOTO et. al. U.S. Patent No. 5,583,615 (Hashimoto hereafter).

Regarding claims 1, 5 and 9, Hashimoto teaches substantial features of the invention as claimed, shown on Fig. 4, a network comprising, a first computer (18) (Fig. 6 col 5/line 56-col 6/line 51), a network device (1) (Fig. 1 col 3/line 56-col 5/line 52) communicatively coupled to said network;

accessing the network device by a first computer to obtain device information of the network device (col 8/lines 55-60), the information including information obtained from detector or meter ("sensors") device of the network device (col 8/lines 25-30) further including usage information of the network device (col 8/lines 61-66, col 10/lines 39-42 and Fig. 14A & 15A);

storing the obtained device status information at the first computer (col 8/lines 57-60);

periodically processing the stored status information to generate a collection of the obtained information (called "usage report") for the network device (col 9/lines 14-18, 57-59, and col 10/lines 5-7, 16-19);

transmitting the usage report from the first computer to a second computer (16) (col 9/lines 36-55); and

receiving the usage report by the second computer (col 15/lines 47-51).

Regarding claim 2, transmitting the usage report to the second computer at a predetermined time or upon the occurrence of a predetermined event (col 9/lines 14-59 and col 10, lines 5-19).

Regarding claim 3, the network device is a copier (Figs. 15A-B), and the usage report includes a number of copies made by the copier over a predetermined period (col 9/lines 7-18).

Regarding claims 6-7, these system claims are substantially the same as the method claims 2-3, discussed above, same rationale of rejection is applicable.

Regarding claims 10-11, these computer program product claims are substantially the same as the method claims 2-3 and the system claims 6-7, discussed above, same rationale of rejection is applicable.

Claim Rejection under 35 U.S.C. 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hashimoto in view Danknick et. al. U.S. Patent No. 5,901,286 (Danknick hereafter)

Regarding claims 4, 8 and 12, however the Hashimoto reference does not teach the use of HTML or Excel formats in its usage reports;

Danknick discloses as prior art accessing a network device by a computer to obtain the network device's status information including converting the obtained status information to an HTML format (col 1/lines 45-48), furthermore teaching relocatable software executing on a computer configured to translate information regarding status information associated with usage in a network device into a HTML format for rendering as a web page (col 10/lines 30-36) or other formats (col 12/lines 42-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of Hashimoto for monitoring a network device by accessing its status information a including displaying the obtained data received via modem telephone based network to include supporting the access to network device status information via a telephone network, motivation would be to further enhance Hashimoto's system with existing technology such as high speed digital lines, e.g. high speed integrated digital network (ISDN) telephone lines enabling Web based monitoring functions as set forth by Danknick.

16. Claim 1, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Barrett et. al. U.S. Patent No. 5,935,262 (Barrett et. al).

Regarding claims 1, 5 and 9, Barrett discusses as prior art;

accessing a network device by a first computer to obtain device status information of the network device, including information obtained from detector or counter ("sensors") of the network device (col 1/lines 44-50);

storing the obtained device status information for further processing (col 1/lines 51-55); processing the stored status information to generate a ("usage report") collection of information for the network device (col 1/lines 51-55);

transmitting the usage report from the first computer to a second computer (col 1/lines 51-55); and receiving the usage report by the second computer (col 1/lines 51-55); however Barrett does not explicitly disclose where the processing of status information. It would have been obvious to one ordinary skilled in the art at the time the invention was made to perform task periodically motivated by Barrett's disclosure for example, to periodically process the status information according to maintenance or billing cycle for which the status information is obtained and used for, as disclosed by Barrett.

17. Applicant is reminded of 37 CFR 1.530 (e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there MUST also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper (see MPEP 2234). There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96; however, with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02, and 2163.06. ("Applicant should specifically point out the support for any amendments made to the disclosure.") (see MPEP § 2163.04).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

B. Prieto
TC 2100
Patent Examiner
August 19, 2004